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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,043	08/02/2001	Takayuki Doki	TMI-103	7787

24956 7590 07/27/2004

MATTINGLY, STANGER & MALUR, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/857,043

Applicant(s)

DOKI, TAKAYUKI

Examiner

Calvin L Hewitt II

Art Unit

3621

*J*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-25-02, 12-16-02</u>   | 6) <input type="checkbox"/> Other: _____                                    |

***Status of Claims***

1. Claims 1-17 have been examined.

***Claim Objections***

2. Claims 10, 12, 13, and 17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 10, 12, 13, and 17 are dedicated to media. However, claim 1 from which claims 10, 12, 13, and 17 depends is dedicated to a system.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 7-13, and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 1 recites the limitation "the media" in line 5. Claim 1 recites "prescribed media" in line 6. Claim 9 recites the limitation "the user-specific information" in line 6). Claim 15 recites the limitation "said media units" in line 3. There is insufficient antecedent basis for this limitation in the claims.

Claims 7-13 and 15-17 are also rejected because they depend from claim 1.

B.

I. Claims 1-6 recite the use of media, prescribed media, and ID numbers (e.g. an, specific). Claim 1, for example, recites "the media" (line 5) and "prescribed media" (line 6). More specifically, claim 2 recites "an ID number" in line 5 and again in line 13.

However, it is not clear to one of ordinary skill that after this second recitation, when a "the ID number" is referenced in the rest of the claim or in dependent claims which ID number is being referred to. In general, claims 1-6 are not clear as they are inconsistent in their reference to ID numbers and media such that one of ordinary skill

can construe the presence of multiple ID numbers and media, as opposed to one.

Claims 3 and 7-17 are also rejected as they depend from claims 1, 2, or 4-6.

II. Claim 4 recites a settlement management device that receives a validation query from a settlement authentication device however this is recited using conditional language (e.g. "when"). Further, in the limitation that describes the actions of the settlement authentication device, absent is such a query. Claim 4 is silent regarding how the system is to perform if there is no query or if there is a matching ID, hence, one of ordinary skill is hindered from determining how to use Applicant's system and the scope of said system. Claim 11 is also rejected because it recites similar conditional language.

Claim 14 is also rejected because it depends from claim 4.

III. Claims 10, 12, 13, and 17 are dedicated to media. However, claim 1 from which claims 10, 12, 13, and 17 depend, is dedicated to a system. Specifically, the structure of claim 1 comprises a terminal device and an authentication device. Therefore, limitations

that further describe the media are outside the system. Further, it is not clear to one of ordinary skill how the "media" of claim 17 is utilized in the system of claim 1.

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Connecting the settlement authentication device to the terminal device in order to receive the request for service along with the ID.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 11, 12, 14, 16, and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stimson et al., U.S. Patent No. 5,511,114.

As per claims 1-7, 11, 12, 14, 16, and 17 Stimson et al. teach a service utilization ID number settlement system comprising:

- a settlement terminal that reads an ID number recorded on media at the time of settlement for prescribed media to cause the input of balance information equivalent to the amount of money paid in association with the ID number, and to transmit said ID number in association with said balance information (figures 1 and 3; column/line 3/64-4/51; column 5, lines 42-60)
- a settlement authentication device that stores balance information in association with said transmitted ID number to determine if a service can be provided based on a balance and deducting a service amount if the service can be provided (figure 1; column 3, lines 52-63; column 5, lines 5-42) stores sub-ID numbers and determines whether a service can be provided based on a comparison between sub-ID and transmitted ID (column 5, lines 19-41)
- reading an ID number from media and in response specifying a service and balance information equivalent to desired service (column 4, lines 17-30)
- a settlement management device that receives ID and service information and transmits ID and service information to an authentication device (figure 1; column/line 4/52-5/4) , and validates and stores ID number in association with the balance information (column 6, lines 37-44)

- storing ID number transmitted from a settlement management device in association with said balance information (figure 4; column 3, lines 53-63; column 5, lines 5-28)
- a service selection device for receiving ID number, service specification and transmitting the number and service (figures 1 and 3; column 5, lines 5-28)
- prohibiting provision of service if ID number is not validated or balance is insufficient (column 5, lines 5-60)
- paper pre-paid media with a face value (column 1, lines 10-58; column 5, lines 5-60)
- transmitting user deposit information (column 5, lines 42-60)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al., U.S. Patent No. 5,511,114.



As per claim 8, Stimson et al. teach a service utilization ID number settlement system that uses a card, ID number and account balance to determine whether a service can be provided (column 5, lines 5-60). To one of ordinary skill, it would have been obvious to combine the balances from multiple cards, associated with a user and/or user account, in order to produce sufficient funds for making a call (*In re Harza*, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960)).

As per claim 9, replacement card processing is old and well-known.

As per claim 15, it is at least obvious to provide unique numbers for each card in order to correctly access card balance data (figure 4)

10. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al., U.S. Patent No. 5,511,114 in view of Cohen, U.S. Patent No 6,422,462.

As per claims 10 and 13, Stimson et al. teach a service utilization ID number settlement system that uses a card where the card is paper and bears an ID number (column 2, lines 35-48). However, Stimson et al. do not specifically recite a plurality of cards each with different ID numbers. Cohen teaches issuing a user a plurality of paper cards with different IDs (column 4, lines 1-18). Therefore, it would have been obvious to one of ordinary skill to combine the

teachings of Stimson et al. and Cohen in order to create cards that meet the specific needs of users ('462, abstract).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Dorf teaches a multifunctional card
- Bonicalzi et al. teaches a system for authentication papers such as credit cards
- Fite et al. disclose pre-paid card system

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100

Art Unit: 3621

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and  
after-final communications),

or:

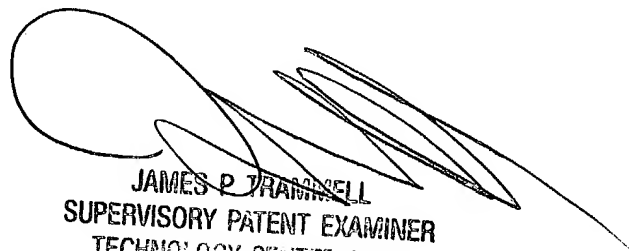
(703) 746-5532 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)  
308-1113.

Calvin Loyd Hewitt II

July 13, 2004



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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